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10/689,172

10/20/2003

Duane A. Lunsford

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03/24/2009

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EXAMINER

DESAI, ANISH P

ART UNIT

PAPER NUMBER

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ELECTRONIC

Please find below and/or attached an Office communication concerning this application or proceeding.

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DETAILED ACTION



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BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Application Number: 10/689,172
Filing Date: October 20, 2003
Appellant(s): LUNSFORD ET AL.

Mr. Thomas M. Spielbauer
For Appellant

SUPPLMENTAL EXAMINER'S ANSWER

Art Unit: 1794

1. This is in response to the Order Returning Undocketed Appeal to the Examiner on 01/27/09. The previous Examiner had mailed Supplemental Examiner's Answer on 09/04/07 without Director Designee signature.

2. In order to comply with the aforementioned order, the Supplemental Examiner's Answer now includes the Director signature.

3. The Supplemental Examiner's Answer is following:

4. As requested by the Board on page 3 of the Remand Order of April 30, 2007 (Issue 1) appellants have submitted a corrected Evidence Appendix for their Brief.

5. As regards Issue 2 which is set forth on pages 3-4 of the Remand Order the Examiner has the following observations. It is first and foremost noted that all prior art rejections based in whole or in part on EP '756 had been withdrawn by the Examiner in the Advisory Action of January 6, 2006 following the Final Rejection of October 28, 2005. Thus all earlier relied upon rejections based in some part on EP '756 are moot issues that are no longer needed to be considered by the Examiner. As regards appellants' comments, particularly in the Reply Brief, that EP '756 "teaches away" from the claimed invention the Examiner can only note that neither reference mentions the other, and Lange et al is totally silent with respect to the presence of ambifunctional silanes, a major element of the '756 primer system.

6. In summary, it is the Examiner's firm conviction that the relied upon Lange et al does not teach away from the claimed invention.

7. As regards the claimed no more than 3% by weight acrylic acid repeat units adhesive composition discussed by the Murray Declaration note the Examiner's

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comments beginning at page 3 of the Answer, 3 lines from the bottom of the page and continuing onto page 4. Here the Examiner states that although the only specific adhesive composition taught in Lange et al is the Murray Declaration discussed Scotch Brand Magic Tape acrylic composition, a specific trademark only identified composition whose specific composition are nowhere disclosed in the reference, even if one agrees with appellant that the claimed invention excludes this composition (which the Examiner does not), "there still remains the previously referred to disclosure of Col 4, lines 5-9 specifically stating that excellent results are obtained when using the disclosed primer to adhere "adhesives" to, e.g. polyester films". That is, note (Answer, page 4, next to last line) that Col 4, lines 5-9 clearly teaches "...that the reference primer is very suitable as a primer for adhering adhesives to substrates, with no restriction whatsoever on the type of adhesive used".

Respectfully submitted,

/Anish Desai/

Examiner, Art Unit 1794

Director or Director Designee's Signature

/Jennifer Michener/

Director Designee, TC 1700

QAS, TC1700

Application/Control Number: 10/689,172

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